

REMARKS

I. Overview

These remarks are set forth in response to the New Non-Final Office Action. As this amendment has been timely filed within the six-month statutory period, but three months subsequent to the shortened statutory period, a three-month petition for extension of time and corresponding fee is provided herewith. Presently, claims 1 through 19 are pending in the Patent Application. Claims 1, 9 and 17 are independent in nature. In the New Non-Final Office Action, the Examiner has rejected claims 1 through 19 under 35 U.S.C. § 112, first paragraph. Additionally, the Examiner has rejected claims 1 through 19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,988,138 to Alcorn et al. (Alcorn).

II. The Applicant's Invention

The Applicants have invented a method and system for finding, managing and sharing learning materials in a learning management system. In accordance with the principles of the Applicants' invention, a user of the learning management system, otherwise referred to as a "learner", can select from various learning materials in a learning management system, otherwise known as "learning objects." To be able to easily retrieve, manage, and share these materials, the learner can aggregate selected learning objects into an ad-hoc category or "learning folder", which is established on the learning management system separately from an existing selection of learning objects. The learner can further create and delete learning folders, and can add or remove learning objects to and from the folder. Even yet further, a user can allow other learners on the system to access the folder by establishing a "learning link" for the folder. Each learning link can then specify which other learners can access the learning folder.

III. Examiner's Re-Opening of Prosecution

On August 6, 2008, Examiner issued the New Non-Final Office Action in response to Applicants' Appeal Brief. The New Non-Final Office Action indicated in the very first sentence,

A request for continued examination under 37 C.F.R. 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(c) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 5/27/2008 has been entered.

Applicants, upon receiving the New Non-Final Office Action promptly telephoned Examiner and left a voice message indicating the mistake in that NO REQUEST FOR CONTINUED EXAMINATION had been filed by Applicants. Examiner responded subsequently by telephone that the error was noted. Applicants correctly relied upon Examiner's acknowledgment of error and took no further action. Thereafter, on December 11, 2008--more than three months subsequent to the New Non-Final Office Action--Examiner issued an "Office Communication" indicating that prosecution is re-opened based upon a "new ground of rejection".

Alarminglly, Examiner did not reset the time to respond to the New Non-Final Office Action despite Examiner's admission that a mistake had been made in the New Non-Final Office Action. Applicants spoke with Examiner telephonically on January 6, 2009 and requested Examiner to reset the time period to respond to the New Non-Final Office Action considering Examiner's admitted mistake and the Examiner having notified Applicants of the mistake only AFTER the three month shortened statutory period had expired. Examiner consulted with Examiner's supervisor and returned Applicant's phone call also on January 6, 2009. In that

telephone call, Examiner indicated that Examiner's supervisor REFUSED to reset the time period to respond despite the clear error of Examiner.

Applicants are disappointed and confused by the degree of demonstrated inflexibility in that the Examiner admitted to a clear mistake, Applicants relied upon Examiner's admission, yet after several months, Examiner required Applicants to pay the price for Examiner's mistake. Examiner at the direction of Examiner's supervisor should have withdrawn the New Non-Final Office Action and reissued the same on December 11, 2008 upon discovery of the mistake in asserting Applicants had filed an RCE when in fact Applicants had not. To do so would have not required substantial effort on the part of the Examiner. Instead, Examiner and Examiner's supervisor chose to punish Applicants for Examiner's mistake. The USPTO publicly states that the USPTO strives to provide enhanced customer service. The USPTO in this case has not provided the degree of customer service for which it strives and has engaged in behavior that serves only to fuel a negative public perception of the ability of the USPTO to efficiently and proactively serve its customers.

IV. Rejections Under 35 U.S.C. § 112, First Paragraph

Applicants have amended claims 1, 9 and 17 to strike the "catalog" verbiage complained of by Examiner and has replaced the same with "an existing selection of learning objects" that is separate from the learning folder. Applicants' amendment is directly supported by the teachings of Figure 1. As such, no new matter has been added and the language in question has been removed from each of claims 1, 9 and 17. Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, first paragraph is required.

V. Rejections Under 35 U.S.C. § 102(b)

A. U.S. Patent No. 6,988,138 to Alcorn et al. (Alcorn)

Alcorn claims a system and methods for implementing education online by providing institutions with the means for allowing the creation of courses to be taken by students online, the courses including assignments, announcements, course materials, chat and whiteboard facilities, and the like, all of which are available to the students over a network such as the Internet. In Alcorn, various levels of functionality are provided through a three-tiered licensing program that suits the needs of the institution offering the program. In addition, an open platform system is provided such that anyone with access to the Internet can create, manage, and offer a course to anyone else with access to the Internet without the need for an affiliation with an institution, thus enabling the virtual classroom to extend worldwide.

B. Argument

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.² Absence from an allegedly anticipating prior art reference of any claimed element negates anticipation.³

¹ *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) ("To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently"), *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986)(emphasis added).

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a **proper construction of the claims**. ... The second step in the analyses requires a comparison of the **properly construed claim** to the prior art."⁴ During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"⁵ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁶ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁷ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁸ This burden has not been met.

Specifically, on page 4 of the New Non-Final Office Action, Examiner refers only to column 5, lines 15 through 25 of Alcorn in support of Examiner's assertion that Alcorn discloses the establishment in an LMS of a learning folder that is separate from an existing course catalog of learning objects. Though Examiner has failed to engage in a proper claim construction as required by the law, Examiner implicitly construes the essential claim term "learning folder" by comparison to column 5, lines 15 through 25 to mean, "user accounts". For the convenience of Examiner, the entirety of column 5, lines 15 through 25 of Alcorn is provided herein:

⁴ Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁵ In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007) ("[T]he PTO must give claims their broadest reasonable construction consistent with the specification. Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation."); In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁶ In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

⁷ See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁸ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

In another aspect if the invention, provided is a system for providing to a community of users access to online courses, including a server computer in communication with user computers over a network, wherein the server computer has means for **creating course user accounts** from a file of existing user accounts associated with an external computer. In this manner, existing legacy systems having large members of user accounts stored in memory may be integrated with this system without having to re-enter user data into the system (so-called batch enrollment).

Obviously, Examiner's comparison of "learning folder" to "user accounts" is flawed and would be reversible error on Appeal.

The term "learning folder" given its broadest reasonable interpretation is "a folder of learning objects". Applicants have used the term "learning folder" consistently with its plain meaning as will be apparent by reference to paragraphs [0014] and [0015] of Applicants' specification in which Applicants state:

To be able to easily retrieve, manage, and share these materials, the learner can aggregate selected learning objects into an ad-hoc category or 'learning folder', which is established on the learning management system.

As set forth in M.P.E.P. 2111, "During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. Specifically, the Federal Circuit's en banc decision in Phillips v. AWH Corp., 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard.⁹ Examiner's improper claim construction of "learning folder" as merely a user account

⁹ The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Cir., 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

exceeds the legal standard for claim construction during examination and inhibits Examiner's ability to properly compare the cited art to Applicants' claims.

It goes without saying, Examiner's failure to properly construe "learning folder" necessarily results in Examiner failing to locate the critical limitation,

establishing within a computing system a learning folder for a particular learner in the learning management system (LMS) which is separate from an existing selection of learning objects, the learning folder comprising a configuration to aggregate access to learning objects from the separate existing selection of learning objects;

Examiner has provided no demonstrable evidence that Alcorn provides a teaching directed to "establishing within a computing system a learning folder for a particular learner in the learning management system (LMS)", let alone the separate nature of the learning folder from an existing selection of learning objects as substantially claimed in claims 1, 9 and 17. Examiner bears the initial burden in providing such an express teaching in Alcorn and Examiner's failure to do so necessarily negates anticipation under the law.

Examiner may choose to argue that Examiner's specific reference to column 5, lines 15 through 25 of Alcorn for such a teaching is merely representative of the Alcorn teachings and that Applicants bear the responsibility to consider the entirety of the Alcorn reference. To do so also would be an instance of clear error reversible on Appeal. Rather, as noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,⁹ a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." The Courts that are in a position to review the rejections set forth by the Examiner

(i.e., the Board of Patent Appeals and Interferences, the Federal Circuit, and the Supreme Court) can only review what has been written in the record; and therefore, **the Examiner must clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection.**

This requirement that the Examiner clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection is found in with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. **When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.** The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Moreover, in the unpublished opinion of Ex parte Pryor¹⁰, the Board of Patent Appeals and Interferences recognized the necessity for an Examiner to supply sufficient information to establish a prima facie case of anticipation. Specifically, the Board wrote:

At the outset, we note the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements between the instant claims and the applied reference, fails to clearly make out a *prima facie* case of anticipation. (emphasis in original)

Despite the very specific requirement for the Examiner to clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner, the Examiner has failed to do so. Instead, the manner in which the Examiner conveyed the statement of the rejection has not "designated as nearly as practicable"

the particular parts in Alcorn being relied upon in the rejection aside from the clearly deficient column 5, lines 15 through 25 of Alcorn.

Even still, to the extent Examiner has relied upon other portions of Alcorn in establishing the presence of the first limitation of claims 1 and 9 in Alcorn, Applicants observe that it would have been practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within Alcorn being relied upon to teach each of the particular claimed elements. For example, the Examiner could have "specifically identified" a feature, corresponding to the claimed element, within Alcorn by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner could have cited to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within Alcorn that identifies the feature that corresponds to the claimed element. However, merely citing one paragraph to disclose multiple claimed elements of claims 1, 9 and 17 does not designate, "as nearly as practicable," the particular features within Alcorn being relied upon by the Examiner in the rejection.

The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is also further evident in M.P.E.P. § 706.07, which states:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

A clear issue, however, cannot be developed between Applicants and the Examiner where the basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis" provides little insight as to (i) how the Examiner is interpreting the elements of the claims and (ii) what specific features within Alcorn the Examiner believes identically discloses the specific

elements (and interactions between elements) recited in the claims. By failing to specifically identify those features within Alcorn being relied upon in the rejection, the Examiner has essentially forced Applicants to engage in mind reading and/or guessing to determine how the Examiner is interpreting the elements of the claims and what specific features within Alcorn the Examiner believes identically disclose the claimed invention.

VI. Conclusion

The Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §§ 112, first paragraph and 102(b) owing to the canceled and amended claims and the foregoing remarks. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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